

Application No.: 10/042,473

REMARKS

The Office Action of April 9, 2004 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

As indicated above, the specification and drawings have been amended to correct informalities noted therein during a review of the application. Support for the drawing changes is found at page 5, line 30 of the as-filed application. Claim 1 has been amended to add the limitation of "an outlet for liquid containing dissolved ozone." Support for this amendment is found in the published application at page 1, line 10 - page 3, line 2, page 5, lines 8 - 24 and page 6, lines 25 - 32, as well as Figures 1, 3, and 7. Claim 9 has been cancelled.

Turning now, to the office action, claim 9 was rejected under 35 USC §112, first paragraph, for failing to comply with the enablement requirement, and under 35 USC §112, second paragraph, as being indefinite. Claims 1 - 7 and 10 - 32 were rejected under 35 USC §102 as being anticipated by Burris 5,213,773 ('773), cited by Applicants. Claims 8 - 9 were rejected under 35 USC §103 as being unpatentable over '773 in view of Burris 5,422,043 ('043) or Burris 5,858,283 ('283), both of which were cited by Applicants.

It is respectfully noted that claim 9 has been cancelled without prejudice or disclaimer to the subject matter contained therein. Accordingly, the rejections under 35 USC §112, first and second paragraph, are believed to be overcome by cancellation.

Turning now to the rejection of claims 1 - 7 and 10 - 32 under 35 USC §102 as being anticipated by '773, as noted above, Applicants have amended claim 1 to add the recited limitation of "an outlet for liquid containing dissolved ozone," and do not believe this limitation to be taught or suggested by '773. Furthermore, while '773 discloses liquid that may contain dissolved ozone for a limited period of time, it does not teach an apparatus for outputting or dispensing liquid containing dissolved ozone. The '773 patent teaches, throughout the description, the dispensing of a treated liquid (a liquid which has been sufficiently contacted with an ozone-containing gas), for example, column 1 lines 55 - 60. A person of ordinary skill in the art will realize that this does not mean that the liquid must contain dissolved ozone. The term "treated" is past tense and refers to liquid that has been treated with ozone-containing gas and, since ozone has a short life in liquid, the ozone gas reverts to

Application No.: 10/042,473

oxygen in short order. Thus, after the contact period the ozone is depleted. Hence, the teaching in '773 of treatment of water contacted with an ozone-containing gas does not require that the dispensed liquid contain dissolved ozone. In view of the amendment to claim 1, Applicants respectfully urge that claim 1 is not anticipated by '773. Insofar as claims 2 - 7 and 10 - 32, are concerned, these claims all depend from now presumably allowable amended claim 1 and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to claim 1.

With respect to dependent claims 2 - 7 and 10 - 32, these dependent claims were also rejected as being anticipated by Burris '773, yet the Examiner failed to identify specific teachings within '773 to support such rejections. For example, the Examiner failed to indicate where a corona discharge generator (claim 3), excess ozonated liquid being recirculated (claim 13), or a removable liquid reservoir (claim 23) are taught in '773. Accordingly, Applicants respectfully submit that the rejection is incomplete. In the event that this rejection is maintained in a subsequent Office Action, particularly with respect to the dependent claims, Applicants respectfully request that the Examiner specifically set forth the teachings relied upon to support each claim rejection, and that Applicants be provided an opportunity to respond to such rejections in detail or to amend claims to overcome a proper rejection.

Turning next to the rejection of claims 8 - 9 under 35 USC §103 as being unpatentable over '773 in view of '043 or '283, claim 9 has been cancelled and the disclosures of the cited patents and the distinctions between claim 8, which also depends from claim 1, may be briefly described as follows. Additionally, the distinction relative to claim 1 are set forth above and Applicants incorporate those arguments in traversal of the 35 USC §103 rejection as well.

The Examiner fails to indicate, other than the apparent reliance on the claims of the instant application as a "recipe" for the piecemeal combination of elements, what teaching or suggestion he relies upon for the motivation to make the proposed combination and modification of the '773 teachings. Absent a teaching or suggestion of the problem addressed or advantages achieved by the limitation, *prima facie* obviousness is not established.

Considering, *in arguendo*, the combination of '773 in view of '043 or alternatively '283, as noted by the Examiner, '773 does not teach the use of a diffuser to disperse ozone-containing gas into a liquid. However, the Examiner has asserted that '043 or

Application No.: 10/042,473

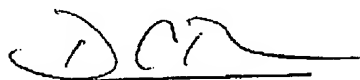
'283 both teach the use of a gas diffuser. Neither '043 or '283 teach the additional limitation of amended claim 1, where the portable manually operated batch operation device includes "an outlet for liquid containing dissolved ozone." Hence, even if the arguable, alternative combinations set forth by the Examiner were deemed to establish *prima facie* obviousness, no teaching is found relative to the additional limitation of claim 1, and therefore dependent claim 8. Thus, dependent claim 8 is respectfully asserted to be patentably distinguishable over the combination.

Here again, Applicants respectfully urge that the rejection is either improper or has been overcome by the amendment to claim 1, and anticipate the withdrawal of the rejection and an indication that claim 8 is allowable in a subsequent communication from the Examiner.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



Duane C. Basch
Attorney for Applicant
Registration No. 34,545
Basch & Nickerson LLP
1777 Penfield Road
Penfield, New York 14526
(585) 899-3970

DCB/dcb